

Remarks

Based on the amendments to the claims and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Applicants wish to express their appreciation of the helpful discussion provided by the Examiner and her Supervisory Patent Examiner during the personal interview of June 12, 2003.

I. Status of the Claims

Upon entry of this amendment, claims 1, 2, 9-25, 28-41, 43-56, 58-61, 64-66, and 68-70 are pending, with claims 1, 53, and 54 being independent claims. Claims 1, 2, 12, 14, 16, 18, 20, 22, 24, 53, 54, 56, 58, and 70 are amended herein. Support for these amendments can be found throughout the specification as filed. No new matter has been introduced by these amendments.

Claims 1, 53, and 54 have been amended to incorporate the language of previously pending claim 63.

II. Summary of the Office Action

In the Office Action dated March 26, 2003, the Examiner made 7 rejections of the claims. Since the presently pending independent claims incorporate the language of previously pending claim 63 into the independent claims, those rejections that do not include the previously pending claim 63 are moot.

In the Office Action, claim 63 was rejected over Wang *et al.* (International Symposium on Biology of Prostate Growth, March 1998, document AS18 of the IDS filed 2/15/2002). Applicants respectfully offer the following remarks to overcome this rejection as it may be applied to the newly presented claims.

III. The Rejection of Claims 1, 2, 4, 5, 9, 10, 11, 12, 33-38, 40, 41, 43-46, 51, 53-56, 59, and 62-70 Under 35 U.S.C. § 102(a) As Allegedly Being Anticipated by Wang et al. Must Be Withdrawn.

In the Office Action at page 2, section 3, claims 1, 2, 4, 5, 9, 10, 11, 12, 33-38, 40, 41, 43-46, 51, 53-56, 59, and 62-70 have been rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Wang *et al.* Applicants respectfully request reconsideration and withdrawal of this rejection in view of the attached declaration under 37 C.F.R. § 1.131 executed by Drs. Ts'o and Lesko.

35 U.S.C. § 102(a) reads:

A person shall be entitled to a patent unless

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign, before the invention thereof by the applicant for patent,

Wang *et al.* is an abstract of a poster presented during the International Symposium on Biology of Prostate Growth, March 15-18, 1998, at the National Institutes of Health, Bethesda, MD. Applicants respectfully submit that the invention described in Wang *et al.* was invented by Applicants prior to the date of Wang *et al.* Applicants submit herewith a declaration accompanied by a showing of facts establishing a reduction to practice of the claimed invention prior to March 15, 1998. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

IV. Change of Inventorship

As Applicants discussed in their submission of November 8, 2002, during the course of preparing that submission, it was determined that the invention claimed in the present application was invented by Dr. Stephen Lesko and Dr. Paul Ts'o and that Dr. Zheng-Pin Wang is not an inventor of the presently claimed methods. Accordingly, Applicants submit herewith a Request to Change of Inventorship of the captioned application under 37 C.F.R. § 1.48(a) to name Stephen A. Lesko and Paul O.P. Ts'o as inventors of the presently claimed invention. The Request is accompanied by a statement under 37 C.F.R. § 1.48(a)(2) from Zheng-Pin Wang that the error in inventorship was made without deceptive intent. In addition, Applicants submit a declaration executed by Drs. Lesko and Ts'o as required under 37 C.F.R. §§ 1.63 and 1.48(a)(3) and the written consent of the assignee as required by 37 C.F.R. § 1.48(a)(5). Accordingly, Applicants respectfully request that the inventorship of the present application be changed to name Drs. Lesko and Ts'o as inventors.

Conclusion

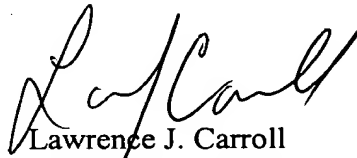
All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will

expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "L. J. Carroll", is written over the printed name.

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